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09/709,038	11/10/2000	ROBERT A. KOCH	36968/202435	3243

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,038

Applicant(s)

KOCH, ROBERT A.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Examiner notes that Claims 1, 2, 8, 9, 12, 24 & 30 have been amended, and no Claims have been cancelled or added since issuance of the prior Office Action. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 3 March 2004 as reiterated herein below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent US 6,564,261 B1 to Gudjonsson.

4. Regarding Amended Claims 1, 12 and 24, Gudjonsson teaches a method, system and interface for identifying to a user an availability of members through their contact devices, (Abstract; Col. 2, lines 51-67; Col. 2, lines 1-63; Col. 34, lines 26-63; Col. 36, lines 41-46; Col. 38, lines 61-67; and Col. 39, lines 1-67), comprising:

- a database for storing profiles of all members of the communications circle, each profile identifying at least one contact device and availability of said device for each member, (Col. 28, lines 9-64);

- a communications server for retrieving the profile from the database and for determining an availability of the contact device for each member in the communications circle, the communications server providing the profile information on the availability of the contact device to the user upon request, (Col. 2, lines 51-67; Col. 3, lines 1-62; and Col. 15, Table 1); and
- wherein the user is able to determine which contact device is available by viewing the profile information, (graphical indicator), on the members of the communications circle and can initiate contact with any member having an available contact device (via selection of that contact device), (Figs. 8 & 9; Col. 3, lines 1-13; Col. 4, lines 31-38; Col. 8, lines 47-67; Col. 9, lines 1-22; Col. 11, lines 44-67; Col. 12; Col. 13, lines 1-18; and Cols. 23-26).

Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Amended Claims 1, 12 and 24.

5. Regarding Amended Claim 2, Gudjonsson teaches a method, system and interface further comprising presenting a graphical indicator that allows the user to select which contact device to initiate communication with each member allowing the user to initiate communications, (through selection), with the member through the graphical indicator on a contact device, (Figs. 8 & 9; Col. 2, lines 51-67; Col. 3, lines 1-62; Col. 11, lines 44-67; Col. 12; Col. 13, lines 1-18; and Cols. 23-26; Col. 38, lines 61-67; and Col. 39, lines 1-67). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Amended Claim 2.

6. Regarding Claims 3 and 14, Gudjonsson teaches a method, system and interface further comprising receiving a notification that the contact device associated with each member is active, (Col. 3, lines 1-13; Col. 8, lines 47-65; and Col. 11, lines 44-52). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 3 and 14.

7. Regarding Claims 4, 16-19, 22 and 23, Gudjonsson teaches a method, system and interface further comprising connecting the user via a communication server, to one of the members in the communication circle, having the active contact device, (per pending Claims 4 and 16), via the Internet, (per pending Claim 17), an email message, (per pending Claim 18), a page, (per pending Claim 19), using an Internet-capable personal computer, (per pending Claim 22), and another Internet-capable communication appliances, (per pending Claim 23), (Col. 2, lines 51-67; Col. 3, lines 1-62). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 4, 16-19, 22 and 23.

8. Regarding Claim 5, Gudjonsson teaches a method, system and interface further comprising storing a communications circle of members for each user, (Col. 28, lines 9-64 and Col. 35, lines 38-64). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claim 5.

9. Regarding Claims 6 and 7, Gudjonsson teaches a method, system and interface wherein determining the availability of the contact device comprises querying the contact device, (per pending Claim 6), or querying the network provider associated with the contact device, (per pending Claim 7), (Col. 2, lines 51-67; Col. 3, lines 1-62; Col. 8,

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lines 47-67; and Col. 9, lines 1-61). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 6 and 7.

10. Regarding Amended Claims 8, 9 and 30, Gudjonsson teaches a method, system and interface wherein allowing the user to select the contact device comprises connecting the user to the contact device, (per pending Claim 8), or sending a message to the contact device, (per pending Claims 9 and 30), (Figs. 8 & 9; Col. 8, lines 47-67; Col. 9, lines 1-61; Col. 11, lines 44-67; Col. 12; Col. 13, lines 1-18; and Cols. 23-26). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Amended Claims 8, 9 and 30.

11. Regarding Claims 10, 11, 15, 28 and 29, Gudjonsson teaches a method, system and interface wherein storing a profile for each member of the communications circle comprises enabling a plurality of contact devices to be stored for each member, (per pending Claims 10 and 28), and storing addressing and availability information for each contact device, (per pending Claims 11, 15 and 29), (Col. 28, lines 9-64). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 10, 11, 15, 28 and 29.

12. Regarding Claim 13, Gudjonsson teaches a method, system and interface wherein the database stores a code number for correlating the profile and communications circle information of the members, (Abstract; Col. 2, lines 51-67; Col. 11, lines 44-52; Col. 16, lines 7-47; and Col. 28, lines 9-64). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claim 13.

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13. Regarding Claims 20 and 21, Gudjonsson teaches a method, system and interface wherein the contact device is a wireless device, (per pending Claim 20), or an interactive television, (per pending Claim 21), and the user is connected via the communications server through a wireless network or interactive television, (Col. 2, lines 51-67; Col. 3, lines 1-62). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 20 and 21.

14. Regarding Claims 25-27, Gudjonsson teaches a method, system and interface wherein the communication section displays a name of each member in the communication circle, (per pending Claim 25), (Fig. 8; Col. 4, lines 31-33; and Col. 11, lines 44-52), the contact devices associated with each member, (per pending Claim 26), (Fig. 9; Col. 4, lines 34-38; Col. 12, lines 55-67; and Col. 13, lines 1-18), and a link for allowing the user to view the profile section, (per pending Claim 27), (Col. 12, lines 55-67; and Col. 13, lines 1-18). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 25-27.

15. Regarding Claims 31-36, Gudjonsson teaches a method, system and interface wherein the interface is for display on a personal computer, (per pending Claim 31), a wireless device, (per pending Claim 32), a pager, (per pending Claim 33), a wireless telephone, (per pending Claim 34), an interactive television, (per pending Claim 35), or on a personal digital assistant, (per pending Claim 36), (Abstract; Col. 3, lines 51-59; Col. 25, lines 6-9; and Col. 33, lines 6-48). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 31-36.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 21, 35 and 36 are further rejected under 35 U.S.C. 103(a) as being unpatentable over further consideration of US Patent US 6,564,261 B1 to Gudjonsson, which patent is also relied upon for those teachings disclosed herein above. In particular, Examiner notes that Gudjonsson does not specifically enumerate the use of an interactive television or a personal data assistant. To apply the functionalities inherent to the Gudonsson system to an interactive television device or personal data assistant would have been obvious to one of ordinary skill in the art at the time of invention be Applicant. Specifically, as noted above, Gudjonsson indicates the use of client devices, including but not limited to PCs and mobile phones, wherein the Internet and other communication sessions include, but are not limited to text chat, voice chat, web conference or pages, (Col. 3, lines 51-63). As a personal data assistant is a form of portable personal computer and an interactive television is an Internet/web-type communication device, Examiner finds that to incorporate the Gudjonsson system upon the a personal data assistant or an Internet-capable interactive television would have been obvious in light of that which Gudjonsson discloses. Therefore, Claims 21, 35 and 36 are also found to be unpatentable under further consideration of Gudjonsson.

Response to Arguments

18. Applicant's arguments filed 4 June 2004, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how reconsideration avoids such references or objections.

19. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., graphical indicator that allows the user to select which contact device to initiate communication with each member") are not recited in the originally rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

20. Examiner notes that the Claims as amended are still anticipated by the prior art as the user is able to select which device or means by which other users will be contacted via an "invite", wherein the types of "invites" available are graphically indicated, (Figs. 8 & 9), wherein the "routing service" serves to send the invite after the user chooses the device, and wherein the routing service provides an alternative contact or notification means if the means chosen by the user are unavailable at the time. Examiner notes that the routing service does not choose the method by which the

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user sends the message, but rather allows for a means by which messages are received in the event that the user-chosen device is unavailable. In other words, the routing service serves to forward the messages as set up by the receiver as needed, (Col. 25, lines 6-67 & Col. 26, lines 1-36), which removes the need for the user to have specific knowledge of available receiver devices. Therefore, Examiner finds that Gudjonsson anticipates the Claims as amended.

21. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amended claims avoid such references or objections, Examiner hereby maintains the original rejection of all claims, as amended, in their entirety.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703)-305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-6121.

Arrienne M. Lezak
Examiner
Art Unit 2143

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